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A DDI ICATIONINO	EU ING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNET DOCKET NO.	CONFIRMATION NO.
10/688,065	10/16/2003	Christopher R. McGee	020375-033110US	8138
20350 7590 10/17/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER	
			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
	·		3622	
			MAIL DATE	DELIVERY MODE
•			10/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/688,065	MCGEE ET AL.
Office Action Summary	Examiner	Art Unit
	Jeffrey D. Carlson	3622
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w.  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	1.  lely filed  the mailing date of this communication.  D (35 U.S.C. § 133).
Status		
1)☐ Responsive to communication(s) filed on  2a)☐ This action is <b>FINAL</b> . 2b)☒ This  3)☐ Since this application is in condition for allowar closed in accordance with the practice under E	action is non-final. nce except for formal matters, pro	
Disposition of Claims		
4)  Claim(s) 1-21 is/are pending in the application.  4a) Of the above claim(s) is/are withdraw  5)  Claim(s) is/are allowed.  6)  Claim(s) 1-21 is/are rejected.  7)  Claim(s) is/are objected to.  8)  Claim(s) are subject to restriction and/or  Application Papers	vn from consideration. r election requirement.	
9) The specification is objected to by the Examiner 10) The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the of Replacement drawing sheet(s) including the correction  11) The oath or declaration is objected to by the Examiner  9) The specification is objected to by the Examiner  100 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  111 The specification is objected to by the Examiner  111 The specification is objected to by the Examiner  111 The specification is objected to by the Examiner  112 The specification is objected to by the Examiner  113 The specification is objected to by the Examiner  114 The specification is objected to by the Examiner  115 The specification is objected to by the Examiner  116 The specification is objected to by the Examiner  117 The specification is objected to by the Examiner  118 The specification is objected to by the Examiner  118 The specification is objected to by the Examiner  119 The specification is objected to by the Examiner  119 The specification is objected to by the Examiner  119 The specification is objected to by the Examiner  119 The specification is objected to by the Examiner  119 The specification is objected to by the Examiner  119 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to by the Examiner  110 The specification is objected to be the	epted or b) objected to by the Eddrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119		
<ul> <li>12) Acknowledgment is made of a claim for foreign</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents</li> <li>2. Certified copies of the priority documents</li> <li>3. Copies of the certified copies of the priorical application from the International Bureau</li> <li>* See the attached detailed Office action for a list of</li> </ul>	s have been received. s have been received in Applicati ity documents have been receive ı (PCT Rule 17.2(a)).	on No ed in this National Stage
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO/SB/08)  Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	ite

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### **DETAILED ACTION**

## Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - Claim 21, attempts to further define a system which processes criteria, yet it is unclear what structure (i.e. programmed capability) of the system is being further limited by the language hinting at who performs an apparent step of specifying the criteria.

### Claim Rejections - 35 USC § 103

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry et al (US6336098) in view of Fajkowski (US5905246).

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Regarding claims 1, 4, 12, 15, Fortenberry et al teaches a system that enables coupon creators to define coupon parameters, creates, stores and distributes electronic coupons to consumer users [abstract, col 2: lines 10-35]. The coupons can be defined as being redeemable with selected merchants [6:58-65, 7:10-19]. Redemption includes presenting the coupon and verifying that the coupon parameters/restrictions (proper product identifier, proper merchant identifier) are met [2:53-60, 6:1-20]. Fortenberry et al does not teach redemption of e-coupons at a physical retailer using a discount instrument. Faikowski teaches e-coupon redemption at a physical POS where the user presents s coupon card having a user identifier associated therewith [4:4-6]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a card with that of Fortenberry et al so that brick-and-mortar shoppers can use the system of Fortenberry et al for discounts. Fortenberry et al and Fajkowski both speak of preventing coupon fraud and it would have been obvious to one of ordinary skill at the time of the invention to have validated all of the coupon parameters with the central host during POS validation so that the proper discount amount, productID, merchantID can be confirmed before awarding the associated discount.

Regarding claims 2, 3, 13, 14, it would have been obvious to one of ordinary skill at the time of the invention to have indicated that a coupon not being redeemed at the proper merchant or not associated with the proper productID will not be accepted so as to inform the consumer why the attempted coupon failed.

Regarding claims 5-7, 16-18, Fortenberry et al keeps records of all redemption data and it would have been obvious to one of ordinary skill at the time of the invention

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to have preserved failed redemption attempts as well, especially where the prior art indicates a desire to track potential redemption fraud. Any of the data in the stored redemption records can be taken to be "criteria" (for initiating of marketing efforts).

Regarding claims 8-11, 19-21, Fortenberry et al teaches that the retailer can reconcile (receive payments covering the discounted amounts) the coupons. It would have been obvious to one of ordinary skill at the time of the invention to have provided retailers reports that summarize coupon totals in support of the reconciliation process. This would enable the retailers to confirm that they have been properly credited for discounts extended on behalf of the coupon issuers.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D. Carlson Primary Examiner Art Unit 3622

jdc